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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,172	08/18/2003	Bernard F. Grisoni	FC06092-01	3611
24265	7590	03/08/2005		
SCHERING-PLOUGH CORPORATION PATENT DEPARTMENT (K-6-1, 1990) 2000 GALLOPING HILL ROAD KENILWORTH, NJ 07033-0530			EXAMINER KAVANAUGH, JOHN T	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

GN

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/643,172	GRISONI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ted Kavanaugh	3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-19 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-15 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.                                                             | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Drawings***

1. Applicant filed new drawings on May 27<sup>th</sup>, 2004. Figures 9-10 are objected to because they are not accurate. New figures 9-10 show the spring walls 22 sandwiched between the cover layer 18 and the planar member 16. The spring walls are actually extend downward from the planar member and are on the outside. See figures 2,8 and original figures 9 and 10. Applicant's specification also accurately described it as such. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by any of the following references: US 2917846 (Scholl), US 2613456 (Amico), D143642 (Bouthillette), US 2978818 (Baumann), US 2161565 (Freda), US 1867431 (Wood), and US 2660814 (Ritchey (2660814)).

All of these patents show an insert/insole/support having structure as claimed. The raised area of each is in a location that will inherently separate bones of the second and third metatarsals of the foot.

4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by any of the following references: US D475184 (Polifroni) and US 3543765 (Alzner).

All of these patents show an insert/insole/support having structure as claimed. The raised area of each is in a location that will inherently separate bones of the second and third metatarsals of the foot.

5. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by US 532429 (Rogers).

Rogers teaches a pad having a raised area having a generally convex shape (see page 1, lines 38-40 and corresponding to the ball of the foot (B). The raised area of each is in a location that will inherently separate bones of the second and third metatarsals of the foot.

***Claim Rejections - 35 USC § 103***

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5,8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers '429 in view of US 5611153 (Fisher).

Rogers teaches a pad having a plurality of spaced apart walls (b) having a height that generally decrease outwardly from a center (see figure 3 and page 1, lines 38-40) as claimed except for the pad made out of viscoelastic gel; see col. 4, lines 11-16. Fisher teaches the advantages of making the cushioning pad out of a viscoelastic gel. It would have been obvious to make the pad of Rogers out of a viscoelastic gel, as taught by Fisher, to provide better cushioning characteristics.

Regarding claim 8, the walls extend in a zigzag fashion in a lengthwise direction and a traverse direction. Regarding claim 11, pad as shown in figure 1 has a substantially tear drop shape. Regarding claim 12, the examiner takes official notice that it is old and conventional in the art to provide a pad or shoe insert with a low friction cover layer to provide additional comfort to the wearer. Therefore, it would have been obvious to provide the pad of Rogers with a low friction cover layer.

8. Claims 5,8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers '429 in view of either [US 6598321 (Crane '321) or US 2001/0045028 (Crane '028)].

Rogers teaches a pad having a plurality of spaced apart walls (b) having a height that generally decrease outwardly from a center (see figure 3 and page 1, lines 38-40) as claimed

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except for the pad made out of viscoelastic gel and the walls having a sinusoidal wave shape (see claims 13-15). Crane '321 teaches making a cushioning insole out of gel and sinusoidal wave shape spring walls to give the foot of the wearer a softer impact and a spring push off; see col. 5, lines 6-40. Crane '028 teaches making a cushioning insole out of gel and sinusoidal wave shape spring walls to give the foot of the wearer a softer impact and a spring push off. It would have been obvious to make the pad of Rogers out of a viscoelastic gel and the walls having a sinusoidal wave shape, as taught by either Crane '321 or Crane 028, to give the foot of the wearer a softer impact and a spring push off.

Regarding claim 11, pad as shown in figure 1 has a substantially tear drop shape. Regarding claim 12, the examiner takes official notice that it is old and conventional in the art to provide a pad or shoe insert with a low friction cover layer to provide additional comfort to the wearer. Therefore, it would have been obvious to provide the pad of Rogers with a low friction cover layer.

#### ***Allowable Subject Matter***

9. Claims 16-19 are allowed.
10. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

11. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

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-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”


--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 (**FORMAL FAXES ONLY**). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

  
Ted Kavanaugh  
Primary Examiner

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March 5, 2005